

REMARKS

Reconsideration and allowance of the above-identified patent application are respectfully requested in view of the remarks that follow. No amendments are presented in this Response.

Claims 1-6, 8-21, 22-24 and 25-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The term “about” is commonly used in the English language and is defined as “near in time, number, degree, etc.; approximately”, e.g. It's about five miles from here. *Dictionary.com Unabridged (v 1.1). Random House, Inc. 09 Aug. 2007. <Dictionary.com <http://dictionary.reference.com/browse/about>>*. The term is even common in the parlance of the U.S. Patent and Trademark Office. Indeed, in the *USPTO Patent Full-Text and Full-Page Image Database*, the phrase “at least about” is recited in the claims of some **68,738** issued U.S. patents. See, e.g., <http://patft.uspto.gov/netahtml/PTO/search-adv.htm> Search = aclm/”at least about”.

When dealing with the U.S. Patent and Trademark Office, Applicants expect consistency in the application of the U.S. laws, Regulations and Patent Office policies between examination groups and examiners. It is inconceivable to Applicants that the Patent Office could object to the use of the term “about” as recited in Applicants’ claims when the term is used so abundantly in the claims of issued U.S. patents.

Accordingly, is respectfully submitted that rejections under 35 U.S.C. 112, second paragraph, are improper and should be withdrawn.

Claims 1-6, 8-18, 20 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farina, et al., in view of Daddona, et al., and common knowledge in the art as exemplified by Dessouki, et al.

It is noted that claims 19 and 21 are not rejected under 35 U.S.C. 103(a). Applicants respectfully request the Examiner's affirmative statement of the status of these claims under 35 U.S.C. 103(a).

Certainly, it is a trivial matter to reconstruct an invention from the prior art once the invention is known. However, hindsight reconstruction of the invention from the various references is improper. In the present case, the Examiner is urged to consider the cited references as of the time of filing Applicants invention, i.e., February 26, 2004, without prior knowledge of the claimed invention. In an objective analysis, where would the references lead one of ordinary skill in the art?

The Supreme Court recently addressed the issue of obviousness in KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007). The Court stated that the Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966), factors still control an obviousness inquiry. Those factors are: 1) "the scope and content of the prior art"; 2) the "differences between the prior art and the claims"; 3) "the level of ordinary skill in the pertinent art"; and 4) objective evidence of nonobviousness. KSR, 127 S. Ct. at 1734 (quoting Graham, 383 U.S. at 17-18).


Each test for prima facie obviousness applied by the Patent Office, e.g., the "differences between the prior art and the claims"; must be consistent with the legal principles enunciated in KSR. While the KSR Court rejected a rigid application of the teaching, suggestion, or motivation ("TSM") test in an obviousness inquiry, the Court acknowledged the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" in an obviousness determination. KSR, 127 S. Ct. at 1731. Moreover, the Court indicated that there is "no necessary inconsistency between the idea underlying the TSM test and the Graham analysis." Id. As long as the test is not applied as a "rigid and mandatory" formula, that test can provide "helpful insight" to an obviousness inquiry. Id. Thus, in cases involving new methods, it remains necessary to identify some reason that would have led a chemist to modify a known process in a particular manner to establish prima facie obviousness of a new claimed method.

Identifying isolated snippets of information from each reference and combining them in a manner to arrive at Applicants' claims invention is not sufficient to establish a prima facie case of obviousness. It is respectfully submitted that the Examiner has fallen victim to the insidious disease of hindsight reconstruction. Applicants request that the Examiner reconsider the patentability of the invention and withdraw the rejection of claims 1-6, 8-18, 20 and 22-26 under 35 U.S.C. 103(a).

The application contains three independent claims and a total of 25 claims. The Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. 1.17 which may be required, or credit any overpayment, to Account No. 19-3880 in the name of Bristol-Myers Squibb Company.

Respectfully submitted,

Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000



Warren Volles
Attorney for Applicant
Reg. No. 33,810
Phone: 203-677-6997
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